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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,276	05/12/2006	Wolfgang Schnell	SCHNELL-5 (PCT)	1737
25889	7590	05/11/2010	EXAMINER	
COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			YUN, JURIE	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/579,276	Applicant(s) SCHNELL, WOLFGANG	
	Examiner JURIE YUN	Art Unit 2882	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-9, 11-32 and 34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-9, 11-32 and 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 April 2010 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/7/10 has been entered.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "segment marking" as claimed in claim 14 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering

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of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 34 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 34 recites, in part, "a defect marking system corresponding with the radiation source." This limitation is not understood. The disclosure on page 4 states:

A line sensor 5 with image processor is disposed on the support frame 3, below the running side of the conveyor belt 1, which sensor corresponds with the radiation source 4 that lies opposite. In this manner, the rays can be bundled, in optimal manner, in terms of lines.

On one of the two side parts of the support frame 3, a defect marking system 13 is furthermore disposed, specifically in the region between the carrying side and the running side of the conveyor belt 1. Furthermore, the defect marking system is coupled with a control device 14. The defect marking system can place a marking (e.g. a paint spot) on the belt if an irregularity or serious damage is

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detected, making it possible to find the location on the belt again, quickly and easily.

The disclosure teaches the line sensor with image processor corresponds with the radiation source, not the defect marking system. This is recited in claim 8. The defect marking system instead is disposed in the region between the carrying side and the running side of the conveyor belt. This is recited in claim 11. Further, it is not understood how an "irregularity or serious damage" is detected. There is no teaching in the disclosure for how this is done. Claims 2-9 and 11-32 are rejected due to their dependency on claim 34.

5. Claim 14 recites "segment marking" and "start marking". It is not understood how or why these are used. Does this have anything to do with the defect marking system, or is this totally separate from the defect marking system? What is the purpose of the segment and start markings? The disclosure does not explain this. The disclosure on page 4 teaches the defect marking system can place a marking (e.g. a paint spot) on the belt if an irregular or serious damage is detected. But the disclosure does not teach how an irregular or serious damage is detected, or how the defect marking system places a paint spot on the belt.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 16 and 17 recite the limitation "the address of the start marking" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

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8. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 17 recites, in part, "wherein the address of the segment marking and the address of the start marking are separate marking systems." How can an "address" be a "system"?

9. Claims 19, 21, and 22 all recite the limitation "the address of the start marking". There is insufficient antecedent basis for this limitation in the claim. Also, how can an "address" be: "a system" (claim 19), "at last one notch, color strip, reflection zone, metal particle, or permanent magnet" (claim 21), and/or "a code" (claim 22)?

10. Claim 34 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 34 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: means to detect "a result" of the irradiation test performed when the radiation source emits rays toward the belt surface. It is assumed it is the line sensor with image processor that carries out this function, although, as written, it appears to be the defect marking system. However, the defect marking system doesn't appear to detect the rays emitted by the radiation source since it is not in the path of the emitted rays.

11. Claim 34 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such

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omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: the relationship between the defect marking system and the other components of the assembly, such as the radiation source, the line sensor with image processor, the segment marking, the start marking, etc.

12. Claims 2-9 and 11-32 are rejected due to their dependency on claim 34.

Claim Objections

13. Claim 3 is objected to because of the following informalities: there appears to be a typo ("the radiation source the strike..."). Appropriate correction is required.

14. Claim 14 is objected to because of the following informalities: the claim is written very awkwardly and it is not understood what exactly is being claimed. What is the difference between "start marking" and "segment marking"? Appropriate correction is required.

15. Claim 16 is objected to because of the following informalities: in line 3, it appears that the word "side" is missing after "carrying" (i.e. "carrying side"). Appropriate correction is required.

16. Claim 19 is objected to because of the following informalities: in line 1, "Device" should be --The assembly-- in order to maintain consistent language. Appropriate correction is required.

17. Claim 23 is objected to because of the following informalities: in line 2, it appears that the word "code" is missing after "bar" (i.e. "bar code"). Appropriate correction is required.

Response to Arguments

18. Applicant's arguments filed 4/7/10 have been fully considered but they are not persuasive. With respect to the rejection of claim 34 under 35 U.S.C. 112, first paragraph, applicants argue on page 15:

The radiation source corresponds to a defect marking system that must, of course, be disposed in the influence region of the radiation source. In this connection, the arrangement according to claim 11 is preferred.

A process computer now evaluates the result of the irradiation test. In this connection, advantage is taken of a principle on which any radiation test is based: a test body has a radiation state X in an intact state. In a damaged state, it has a radiation state Y. The evaluation in this regard then yields testing results concerning the state of the test body, here: the conveyor belt.

Then on page 17, applicants argue:

These rejections are respectfully traversed. All of the reasons set forth above provide a complete explanation of the present invention so as to enable anyone skilled in the art to make and to use the claimed invention in compliance with the requirements of 35 U.S.C. 112, both the first and the second paragraphs.

Based upon all of the above discussions of the present invention, it is firmly believed that the Drawings, the Specification, and all the claims, are now in complete compliance with all the requirements of 35 U.S.C. 112.

The examiner respectfully disagrees. The explanation given on page 15 of the response by the applicants does not clarify how an "irregularity or serious damage" is detected. There is no teaching in the disclosure for how this is done. Simply stating: "In this connection, advantage is taken of a principle on which any radiation test is based: a test body has a radiation state X in an intact state. In a damaged state, it has a radiation state Y. The evaluation in this regard then yields testing results concerning

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the state of the test body, here: the conveyor belt." - does not explain exactly how the radiation source and corresponding defect marking system detect an irregularity or serious damage. And, it would not be obvious to one of ordinary skill in the art.

Currently, the claim positively recites: (a) a conveyor belt with belt surface, a carrying side and a running side, (b) a device comprising a radiation source and a process computer, and (c) a defect marking system. Everything recited after the "wherein" clause is functional language. The claim as written appears to be missing necessary elements which are needed to make the claim complete and logical. As written, the actual invention is unknown. Thus, the rejection of claim 34 under 35 U.S.C. 112, first and second paragraphs, is maintained.

Conclusion

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JURIE YUN whose telephone number is (571)272-2497. The examiner can normally be reached on Monday-Friday 8:30-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ed Glick can be reached on 571 272-2490. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jurie Yun/
Primary Examiner, Art Unit 2882

April 27, 2010